

Application Serial No. 10/800,603
Reply to Office Action of August 10, 2005

PATENT
Docket: CU-3637

REMARKS/ARGUMENTS

Reconsideration is respectfully requested.

Claims 1-19 are pending in the present application before this amendment. By the present amendment, Claims 1, 7, 9, 13, 16, and 18-19 have been amended. No new matter has been added.

In the office action, claims 1-19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,407,929 (Hale) in view of U.S. Patent No. 6,737,742 (Sweterlitsch).

With respect to the cited Sweterlitsch reference, the applicants respectfully reassert all remarks/arguments of the previously filed amendment of May 27, 2005 and respectfully submit that Sweterlitsch fails to teach every recited limitation of the independent claims 1, 7, 13, and 19. More specifically, the presently claimed invention as recited in these independent claims clearly teaches that the reinforcing member 27A is provided in the substrate body 25. On the other hand, Sweterlitsch's board 230 as allegedly corresponding to the claimed reinforcing member according to the office action is not provided in the base 100 allegedly corresponding to the claimed substrate base. Rather, Sweterlitsch's board 230 is above the base 100.

Even if Sweterlitsch is combined with Hale, the applicants submit that the combination still does not teach or suggest the claimed subject matter of claims 1, 7, 13, and 19, each of which claims has been amended to recite: --wherein a part of the reinforcing member is exposed at a surface of the substrate body--.

That is, even if the Hale's "nonconductive layer 310" (cited in the office action) is combined with Sweterlitsch, the combination still does not teach or suggest, inter alia,

Application Serial No. 10/800,603
Reply to Office Action of August 10, 2005

PATENT
Docket: CU-3637

the claimed invention of the reinforcing member 27A being provided in the body 25—not on the surface of the body—while a part of the reinforcing member 27A is exposed at a surface of the substrate body 25. This is fully supported at least in FIG. 3 and the corresponding disclosure text of the present application. No part of Hale's "nonconductive layer 310" is exposed at a surface of the "electronic package 302."

Further, it is well founded in the patent case law and consistently in MPEP that the examiner bears the **initial** burden of **factually** supporting any prima facie conclusion of obviousness. MPEP §2142. There are three requirements to establish the prima facie obviousness. MPEP §2143.

- (1) First, the prior art references **must** teach or suggest **all** the claim limitations. MPEP §2143.03.
- (2) Second, there must be some suggestion or motivation, either **in the references themselves** or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. MPEP §2143.01.
- (3) Third, there must be a **reasonable expectation of success**. MPEP §2143.02.

It is respectfully submitted that the prima facie burden of establishing the obviousness has **not** been met. None of the three requirements for prima facie obviousness is considered to be factually supported in the office action.

First, as already discussed above, not every claimed limitation is taught or suggested by Sweterlitsch or Hale, as the amended claims 1, 7, 13, and 19 reciting —
wherein a part of the reinforcing member is exposed at a surface of the substrate body—
is not taught or suggested by either one or the combination of the cited references.

Second, no proper suggestion or motivation to combine Sweterlitsch and Hale is

Application Serial No. 10/800,603
Reply to Office Action of August 10, 2005

PATENT
Docket: CU-3637

adequately supported in the references. According to MPEP §2143.01, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference to combine the reference teaching. The suggestion or motivation to combine references must come from the cited prior art references, either explicitly or implicitly. The mere fact that the teachings of the prior art can be modified or combined does not establish a motivation or suggestion to combine and make the resultant combination prima facie obvious. The prior art must suggest the desirability of the combination. MPEP §2143.01.

Namely, there is no teaching or suggestion found in Sweterlitsch that its board 230 can be formed in the base 100 in such a manner that a part of the board 230 is exposed at a surface of the base 100. Further, there is no teaching or suggestion in Hale that its nonconductive layer 310 is exposed at a surface of the electronic package 302. Therefore, there is no adequate teaching or suggestion found in either Sweterlitsch or Hale that it is desirable to combine their teachings to produce the presently claimed invention.

The applicants respectfully submit that the conclusive statement of obviousness in the office action is based on an impermissible presumption. The applicants' response to such a conclusive statement of obviousness is that the basis for improperly finding the presently claimed invention obvious appears to be the teaching found in this application, and not in the prior art. Thus, the obviousness rejection in the office action improperly relies on the **impermissible hindsight reasoning**, because the rejection would not be obvious absent the applicants' disclosure in this application that discloses the claimed —reinforcing member larger than the opening forming portion, provided in

Application Serial No. 10/800,603
Reply to Office Action of August 10, 2005

PATENT
Docket: CU-3637

said substrate body...wherein a part of the reinforcing member is exposed at a surface of the substrate body— (See 37 C.F.R. § 1.104(c)(2).)

According to MPEP §2142, the hindsight reasoning based on the applicants' own disclosure is not permitted. Knowledge of the applicants' disclosure must be set aside. The examiner must step back in time to when the invention was unknown and just before it was made. Only the fact gleaned from the prior art may be used.

Finally, therefore, in absence of any teachings or suggestion in Sweterlitsch that its board 230 can be formed in the base 100 in such a manner that a part of the board 230 is exposed at a surface of the base 100 leads to a conclusion that any attempts to combine Hale's nonconductive layer 310 will inevitably fail to teach or suggest the presently claimed invention. According to MPEP §2143.02, there must be a reasonable degree of predictability of success of the proposed modification or combination of the prior art in order to establish prima facie obviousness. This burden of proof is initially born by the examiner, but the office action fails to provide this.

For the reasons above, the applicants respectfully submit that the prima facie case of obviousness has not been established and accordingly and respectfully request withdrawal of the rejections based on 35 U.S.C. §103.

For the reasons set forth above, the applicants respectfully submit that claims 1-19 pending in this application are in condition for allowance over the cited references. This amendment is considered to be responsive to all points raised in the office action. Accordingly, the applicants respectfully request reconsideration and withdrawal of the outstanding rejections and earnestly solicit an indication of allowable subject matter.

Application Serial No. 10/800,603
Reply to Office Action of August 10, 2005

PATENT
Docket: CU-3637

Should the examiner have any remaining questions or concerns, the examiner is encouraged to contact the undersigned attorney by telephone to expeditiously resolve such concerns.

Respectfully submitted,



Dated: November 9, 2005

W. William Park, Reg. No. 55,523
Ladas & Parry LLP
224 South Michigan Avenue
Chicago, Illinois 60604
(312) 427-1300